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J C PATENTS, INC.			HESS, DANIEL A	
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IRVINE, CA 92618				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* TATAHIRO SAITO

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Appeal 2008-5777  
Application 10/800,386  
Technology Center 2800

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Decided: December 22, 2008

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Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,  
and ELENI MANTIS MERCADER, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

### STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 6-14. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

### INVENTION

Appellant's claimed invention is directed to information code formed by arranging three or more types of display areas in a predetermined arrangement, the display areas having different reflected or radiated wavelength characteristics (i.e., different colors), and wherein the wavelength characteristics of the display areas are combined to form a unit for displaying information (Spec. 4:3-16).

Claim 6, reproduced below, is representative of the subject matter on appeal:

6. An information code comprising a plurality of bars shown on a product, following a predetermined pattern of arrangement according to a conventional black and white bar code structure, said bars including at least three types of bars in such a manner that each of said three types of the bars has a reflected wavelength characteristic different from that of other bars among said three types of the bars so that said reflected wavelength characteristic of said bars when combined forms a unit of displaying information.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Yoshinaga

US 6,073,842

Jun. 13, 2000  
(filed Jul. 7, 1997)

Ackley

US 6,375,075 B1

Apr. 23, 2002  
(filed Oct. 18, 1999)

The following rejections are before us for review:

1. The Examiner rejected claims 6-8 under 35 U.S.C. § 102(e) as being anticipated by Ackley.
2. The Examiner rejected claims 9-14 under 35 U.S.C. § 103(a) as being unpatentable over Ackley in view of Yoshinaga.

#### ISSUE

Appellant contends that the present application antedates Ackley because filing in Japan on November 28, 1997 constitutes constructive reduction to practice. (Br. 4<sup>1</sup>). Appellant further states that since the Japanese application No. 9-328040 was published on June 18, 1999 within one year from the filing date of US provisional application No. 60/170,815, the publication does not constitute a statutory bar to the present application under 35 U.S.C. 102(b) (Br. 4).

The Examiner responds that 35 U.S.C. § 119(a) prohibits reliance on earlier-filed foreign application if such application was filed more than one year before the filing date of the corresponding U.S. application for patent (Ans. 6). The Examiner further states that Appellant misinterpreted the statute to allow asserting priority benefit of the filing date of a foreign application based on the filed provisional application that was filed within one year of the filing date of the

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<sup>1</sup> We are referring to the Appeal Brief filed on October 10, 2006.

foreign application (Ans. 6). The Examiner asserts that this is not a proper interpretation of 35 U.S.C. § 119(a) which is available for an application for a patent and not for a provisional application which is not an application for a patent (i.e., non-provisional application) (Ans. 6-7).

The Examiner further states that because of the prohibition regarding relying on the filing date of an earlier foreign application which was more than one year from the filing date of a non-provisional application for a patent under 35 U.S.C. §119(a), the affidavit may at best be sufficient to show conception as of the Appellant's foreign filing date of November 28, 1997, but is not adequate to establish constructive reduction to practice (Ans. 7). The Examiner states that in order to disqualify Ackley as a 102(e) reference, diligence must be shown from the date of conception to the filing date of the Ackley reference (Ans. 7). The Examiner asserts that no diligence is shown regarding the time between the conception date (Nov. 28, 1997) as argued by Appellant and the provisional application date of December 15, 1999 (Ans. 7). The Examiner concludes that absent a showing of diligence, the evidence is insufficient to disqualify Ackley as a 102(e) reference (Ans. 7).

Thus, the issue before us is whether Appellant presented sufficient evidence to establish reduction to practice prior to October 18, 1999 (the effective filing date of Ackley) or conception of the invention prior to the effective date of the reference coupled with due diligence.

#### FINDINGS OF FACTS

The relevant facts and relevant dates are the following:

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Nov. 28, 1997	Filing of Japanese application No. 9-328040. It is uncontested that this date constitutes conception of the invention.
Oct. 18, 1999	Filing date of Ackley Application 09/419,534 (which became the Ackley 6,375,075 patent).
Dec. 15, 1999	Filing date of U.S. provisional application 60/170,815.
Dec. 4, 2000	Filing date of U.S. Application 09/729,414 under 35 U.S.C. § 111(a) which claimed priority to U.S. provisional application (60/170,815).

## PRINCIPLES OF LAW

The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.

37 C.F.R. § 1.131(b).

“Under 37 C.F.R. § 1.131, the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive (i.e., filing a United States patent application).” MPEP § 715.07(a) (Revision 7, July 2008).

(a) An application for patent for an invention filed in this country by any person who has . . . filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a *WTO member country*, shall have the *same effect* as the same application would have if *filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country*, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

35 U.S.C. § 119(a).

“Section 119 is a ‘patent-saving’ provision for the benefit of . . . constructive reduction to practice to overcome the date of a reference under Rule 131.” *In re Mudler*, 716 F.2d 1542, 1545 (Fed. Cir. 1983).

(b) (1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.

35 U.S.C. § 119(b)(1).

(c) Unless such information is supplied on an application data sheet

in accordance with § 1.76, the oath or declaration must also identify:  
... (2) Any foreign application for patent (or inventor's certificate) for which a claim for priority is made pursuant to § 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing.

MPEP § 1.63 (Revision 7, July 2008).

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in 35 U.S.C. 119(a) through (d) and (f), 172, and 365(a) and (b).

(1)

(i) In an original application filed under 35 U.S.C. 111(a), the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. This time period is not extendable. The claim must identify the foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by specifying the application number, country (or intellectual property authority), day, month, and year of its filing. The time periods in this paragraph do not apply in an application under 35 U.S.C. 111(a) if the application is:

(A) A design application; or

(B) An application filed before November 29, 2000.

MPEP § 1.55 (Revision 7, July 2008).

“If the application properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35



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U.S.C. § 112 by the provisional application.” MPEP § 706.02 VI (D) (Revision 7, July 2008).

### ANALYSIS

As stated *supra*, Appellant has the burden of providing sufficient evidence, in character and weight, to either establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to reference date to the filing of the application. 37 C.F.R. § 1.131(b).

Thus, under the first prong of 37 C.F.R. § 1.131(b), Appellant has to establish reduction to practice prior to the effective date of the 102 (e) reference. Appellant’s declaration and arguments assume that to show reduction to practice as encompassed by “filing of the application” recited in 37 C.F.R. § 1.131(b) includes filing an application for the same invention in a foreign country.

This argument is unavailing. First, “the application” recited in 37 C.F.R. § 1.131(b) means “a United States patent application.” MPEP § 715.07(a). Second, although a foreign application can establish a constructive reduction to practice,<sup>2</sup> Appellant has not shown on this record that the Japanese application 9-328040 constitutes constructive reduction to

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<sup>2</sup> *Mudler*, 716 F.2d at 1545 (“If entitlement to a foreign filing date can completely overcome a reference we see no reason why it cannot partially overcome a reference by providing the constructive reduction to practice element of proof required by Rule 131.”)

practice under 37 C.F.R. § 1.131(b).<sup>3</sup>

On this record, however, Appellant cannot meet the requirements of 35 U.S.C. § 119(a) at least for the reason that the relied-upon foreign application was filed in the Japanese Office more than one year prior to Appellant's U.S. effective filing date of "an original application filed under 35 U.S.C. 111(a)" (i.e., Dec. 04, 2000). Furthermore, according to 35 U.S.C. § 119(b)(1), the non-provisional application<sup>4</sup> did not claim priority during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application (i.e., within 4 months after December 4, 2000 or within 16 months from the filing date of Nov. 28, 1997). MPEP § 1.55. Furthermore, the Declaration of record<sup>5</sup> does not claim foreign priority by specifying the application number, country, day, month, and year of its filing. *See* 35 U.S.C. § 119(b)(1); *see also* MPEP § 1.63.

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<sup>3</sup> While Appellant did not provide sufficient evidence to establish constructive reduction to practice under 37 C.F.R. § 1.131(b), foreign patent applications that satisfy the requirements of 35 U.S.C. § 119(a) enjoy the same benefits as United States patent applications, including the benefit of constructive reduction to practice. As stated *supra*, "Section 119 is a 'patent-saving' provision for the benefit of ... constructive reduction to practice to overcome the date of a reference under Rule 131." *Mudler*, 716 F.2d at 1545.

<sup>4</sup> Note that this section of 35 U.S.C. § 119(b)(1) applies because the application was filed after November 29, 2000 (i.e., December 4, 2000).

<sup>5</sup> Declaration filed on Mar. 12, 2004.

Thus, the Appellant did not show facts, in character and weight, as to establish reduction to practice prior to the effective date of the reference (i.e., Ackley's effective filing date of October 18, 1999). *See* 37 C.F.R. § 1.131(b).

At best, the Japanese application 9-328040 evidences a conception of the invention—not a constructive reduction to practice. Even assuming that this Japanese document evidences a conception of the invention under 37 C.F.R. § 1.131(b) as of the filing of foreign application on Nov. 28, 1997 (i.e., prior to the effective filing date of the Ackley reference of Oct. 18, 1999), Appellant has not provided sufficient evidence to support the due diligence requirement under § 131(b). That is, Appellant has not shown due diligence from October 17, 1999 (which is one day prior to the effective filing date of the Ackley reference) to the filing date of the U.S. application. Under this section, filing of the U.S. application is the effective filing date (i.e., filing of the U.S. provisional application under 35 U.S.C. § 119(e)) provided that claims 6-14 are fully supported under the first paragraph of 35 U.S.C. § 112 by the provisional application. *See* MPEP § 706.02 VI (D).

Thus, Appellant has not shown sufficient evidence, in character and weight, as to establish due diligence from Oct. 17, 1999 (i.e., one day prior the effective filing date of the Ackley reference) to December 15, 1999 (i.e., filing of the U.S. provisional application) under 37 C.F.R. § 1.131(b). As such, the earliest effective filing date for the present application is therefore the filing date of the '815 provisional application (Dec. 15, 1999)--a date after the effective filing date of the Ackley reference (Oct. 18, 1999).

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### CONCLUSION

Appellant has not presented sufficient evidence to establish reduction to practice prior to October 18, 1999 (the effective filing date of Ackley) or conception of the invention prior to the effective date of the reference coupled with due diligence. Thus, the submitted Rule 1.131 affidavit is insufficient to disqualify Ackley as a 102(e) reference and the Examiner's rejections of claims 6-8 under 35 U.S.C. § 102(e) as being anticipated by Ackley and claims 9-14 under 35 U.S.C. § 103(a) as being unpatentable over Ackley in view of Yoshinaga are sustained.

### ORDER

The decision of the Examiner to reject claims 6-8 under 35 U.S.C. § 102(e) and claims 9-14 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw

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